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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,701	12/30/2003	Patrick D. Blattner	06975-534001	2866
26171 7590 03/14/2007 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER VU, THANH T	
			ART UNIT 2174	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/14/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/747,701

Applicant(s)

BLATTNER ET AL.

Examiner

Thanh T. Vu

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-34 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 28 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 28 recites, "a propagated signal" is non-statutory because the claims recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomenal. O'Reilly, 56 U.S. (15 How) at 112-14. Moreover, it does not appear that a claim reciting signal encoded with functional descriptive material falls within any of the categories of patentable subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 15, 18, and 19 recite the limitation "the setting characteristic". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11, and 22-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Liles et al. ("Liles", U.S. Pat. No. 5,880,731).

Per claim 1, Liles teaches a computer-implemented method for animating a first avatar based on perceived animation of a second avatar, the method comprising:

graphically representing a first user with a first avatar capable of being animated (col. 3, lines 28-31);

graphically representing a second user with a second avatar capable of being animated wherein communication messages are being sent between the first user and the second user (col. 3, lines 28-31 and lines 59-62); and

receiving an indication of an animation of the first avatar and in response to and based on the received indication of the animation, animating the second avatar (col. 3, lines 32-41; *a participant can select and initiate an animation employing the avatar in response to an animation of the other participant's avatar*).

Per claim 2, Liles teaches the method of claim 1 wherein receiving the indication of an animation comprises receiving an indication of any type of animation of the first avatar (col. 7, lines 42-47 and col. 8, lines 59-69; *showing various gestures of an avatar*).

Per claim 3, Liles teaches the method of claim 1 wherein receiving the indication of an animation comprises receiving an indication of a particular animation of multiple possible

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animations of the first avatar (col. 7, lines 42-47 and col. 8, lines 59-69; *showing various gestures of an avatar*).

Per claim 4, Liles teaches the method of claim 1 further comprising animating the first avatar in response to and based on the animation of the second avatar (col. 3, lines 32-41 and col. 7, lines 21-23; *a participant can select and initiate an animation employing the avatar in response to an animation of the other participant's avatar*).

Per claim 5, Liles teaches the method of claim 1 wherein the first avatar is animated in response to a particular portion of a message sent between the first user and the second user (col. 9, lines 55-65 and col. 10, lines 28-32; *a participant can select an animation in response to message sent between participants*).

Per claim 6, Liles teaches the method of claim 5 wherein the first avatar is animated in response to a particular portion of a message sent from the first user to the second user (col. 9, lines 55-65 and col. 10, lines 28-32; *a participant can select an animation in response to message sent between participants*).

Per claim 7, Liles teaches the method of claim 5 wherein the first avatar is animated in response to a particular portion of a message sent to the first user from the second user (col. 9, lines 55-65 and col. 10, lines 28-32; *a participant can select an animation in response to message sent between participants*).

Per claim 8, Liles teaches the method of claim 1 wherein the first avatar is animated to send an out-of-band communication from the first user to the second user (col. 6, lines 50-52; col. 9, lines 1-9 and lines 55-65 and col. 10, lines 28-32; *a participant can select an animation or character setting to send between participants*).

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Per claim 11, Liles teaches the method of claim 8 wherein the out-of-band communication comprises a communication indicating a personality characteristic associated with the first user (col. 6, lines 50-67; *character settings*).

Claims 22-27 are rejected under the same rationale as claims 1-8 respectively.

Claims 28-33 are rejected under the same rationale as claims 1-5, and 8 respectively.

Claim 34 is rejected under the same rationale as claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10, and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liles and Kim et al. ("Kim", WO 01/84461 A1).

Per claim 9, Liles teaches the method of claim 8 as described above, but does not teach wherein the out-of-band communication comprises a communication indicating an environmental condition associated with the first user. However, Kim teaches an out-of-band communication comprises a communication indicating an environmental condition associated with a first user (page 2, lines 5-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Kim in the invention of Liles because it provides users with an enjoyable on-line chatting system using various settings for a character in the virtual world that reflect the real world setting of a user.

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Per claim 10, Kim teaches the method of claim 9 wherein the environmental condition comprises an environmental condition related to weather occurring in a geographic location near the first user (col. 2, lines 10-14 and lines 28-30).

Per claims 12 and 13, Liles teaches the method of claim 8, but does not specifically teach wherein the out-of-band communication comprises a communication indicating an emotional state associated with the first user, and a setting characteristic associated with the first user. However, Kim teaches out-of-band communication comprises a communication indicating an emotional state associated with the first user, and a setting characteristic associated with the first user (page 2, lines 5-14). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the teaching of Kim in the invention of Liles because it provides users with an enjoyable on-line chatting system using various settings for a character in the virtual world that reflect the real world setting of a user.

Per claim 14, Kim wherein the setting characteristic comprises a characteristic related to time of day of the first user (page 2, line 21).

Per claim 15, Kim teaches wherein the setting characteristic comprises a characteristic related to time of year (col. 2, lines 5-9).

Per claim 16, Kim teaches wherein the time of year comprises a holiday (col. 2, lines 5-9).

Per claim 17, Kim teaches wherein the time of year comprises a season wherein the season is one of spring, summer, fall or winter (col. 2, lines 5-9).

Per claim 18, Kim teaches wherein the setting characteristic comprises a characteristic associated with a work setting (col. 2, lines 10-14 and lines 29-34; *geographic setting or physical location of the user*).

Per claims 19-21, Kim teaches the setting characteristic comprises characteristic associated with a recreation setting such as a beach setting or a tropical setting and a winter sport setting (col. 2, lines 10-14 and lines 29-34; *it is noted geographic setting where the user lives or physical location of the user may comprises a recreation setting*). ¹⁴

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh T. Vu whose telephone number is (571) 272-4073. The examiner can normally be reached on Mon-Thur and every other Fri 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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